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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,653	06/29/2001	Alan Chris Berkema	10016783-1	9773

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EXAMINER

WALLERSON, MARK E

ART UNIT PAPER NUMBER

2626

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,653

Applicant(s)

BERKEMA ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 2-4,6,15,17,18,21-24,30,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 2-4,6,15,17,18,21-24,30,32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 4/8/05.
2. This application has been reconsidered. Claims 2, 3, 4, 6, 15, 17, 18, 21-24, 30, 32, and 33 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 3, 6, 15, 17, 18, 21, 22, 23, 24, and 30, are rejected under 35 U.S.C. 102(e) as being anticipated by Wolff (U.S. 6,738,841).

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With respect to claims 3, 6, 15, 17, 21, and 30, Wolff '841 discloses a print by reference method executable by a portable wireless device (PDA (210)) the method comprising the steps of obtaining a reference (column 5, lines 33-49) to print content stored at a location (220 and 230) indicated by the reference and wirelessly communicating (column 8, lines 21-58) the reference to another device (250) to initiate a print by reference of the print contents (column 4, line 61 to column 5, line 20 and column 6, lines 1-6), wherein the reference specifies print format information (Options) (column 6, lines 7-20).

Further with respect to claim 6, Wolff discloses specifying a number of copies (which reads on printing a compound document (column 4, line 65 to column 5, line 3)).

Further with respect to claims 15 and 17, Wolff discloses requesting information about the status of the other device (printer) (column 6, lines 7-20).

With respect to claim 18, Wolff discloses displaying the print status message (column 6, lines 7-20).

Further with respect to claim 21, Wolff discloses using the reference to obtain the print content (column 6, lines 1-6).

With respect to claims 22 and 24, Wolff discloses specifying the print device (column 4, lines 61-67 and column 6, lines 27-32).

With regard to claim 23, Wolff discloses receiving the print content from the print service (column 6, lines 1-11).

Further with regard to claim 30, Wolff discloses specifying the print format (column 5, lines 1-2 and column 6, lines 7-20)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (U.S. 6,738,841) (Wolff '841) in view of Wolff (U.S. 5,848,413) (Wolff '413).

With respect to claim 2, Wolff '841 discloses a print by reference method executable by a portable wireless device (PDA (210)) the method comprising the steps of obtaining a reference (column 5, lines 33-49) to print content stored at a location (220 and 230) indicated by the reference and wirelessly communicating (column 8, lines 21-58) the reference to another device (250) to initiate a print by reference of the print contents (column 4, line 61 to column 5, line 20).

Wolff '841 differs from claim 2 in that he does not clearly disclose the reference specifies billing information.

Wolff '413 discloses a method for accessing and publishing electronic documents wherein the information includes billing (charging) information (column 10, lines 31-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff '841 wherein the reference specifies billing information. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff '841 by the teaching of Wolff '413 in order to allow the print provider to charge for services.

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff '841 in view of Lamming (U.S. 5,539,665).

With respect to claim 4, Wolff '841 discloses a print by reference method executable by a portable wireless device (PDA (210)) the method comprising the steps of obtaining a reference (column 5, lines 33-49) to print content stored at a location (220 and 230) indicated by the reference and wirelessly communicating (column 8, lines 21-58) the reference to another device (250) to initiate a print by reference of the print contents (column 4, line 61 to column 5, line 20 and column 6, lines 1-6).

Wolff '841 differs from claim 4 in that he does not clearly disclose the reference specifies time and date information.

Lamming discloses a method of recording and retrieving information wherein the time-stamped and stored chronologically (the abstract and column 2, lines 52-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff '841 wherein time and data information is specified. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff '841 by the teaching of Lamming '665 in order to more clearly specify the images to be retrieved.

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff '841 in view of Nachtsheim (U.S. 6,448,906).

With respect to claims 32 and 33, Wolff '841 discloses a print by reference method executable by a portable wireless device (PDA (210)) the method comprising the steps of obtaining a reference (column 5, lines 33-49) to print content stored at a location (220 and 230) indicated by the reference and wirelessly communicating (column 8, lines 21-58) the reference to another device (250) to initiate a print by reference of the print contents (column 4, line 61 to column 5, line 20 and column 6, lines 1-6).

Wolff '841 differs from claims 32 and 33 in that he does not clearly disclose communicating the reference in Bluetooth format. Nachtsheim discloses a wireless communication method wherein bluetooth methods are used for communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff '841 wherein the reference is communicated in Bluetooth format. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff '841 by the teaching of Nachtsheim in order to improve the communication process.

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Response to Arguments

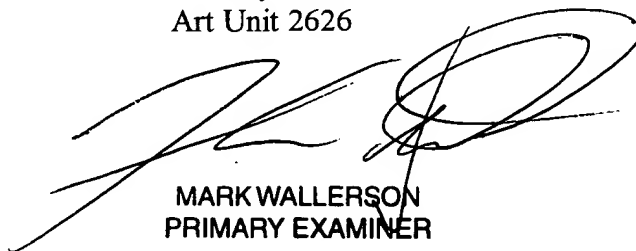
11. Applicant's arguments with respect to claims 2, 3, 4, 6, 15, 17, 18, 21-24, 30, 32, and 33 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626



MARK WALLERSON
PRIMARY EXAMINER